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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/925,650

08/10/2001

Travis J. Parry

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04/28/2004

HEWLETT-PACKARD COMPANY
Intellectual Property Administration
P.O. Box 272400
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EXAMINER

WALLERSON, MARK E

ART UNIT

PAPER NUMBER

2626

DATE MAILED: 04/28/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/925,650

Applicant(s)

PARRY, TRAVIS J.

Examiner

Mark E. Wallerson

Art Unit

2626

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 20 February 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) 1-26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Part III DETAILED ACTION

Notice to Applicant(s)

1. This action is responsive to the following communications: amendment filed on 2/20/04.
2. This application has been reconsidered. Claims 1-26 are pending.

Double Patenting

1. Claims 1-26 are provisionally rejected under the judicially created doctrine of double patenting over claims 1-19 of copending Application No. 09/925,649. This is a provisional double patenting rejection since the conflicting claims have not yet been patented.

The subject matter claimed in the instant application is fully disclosed in the referenced copending application and would be covered by any patent granted on that copending application since the referenced copending application and the instant application are claiming common subject matter, as follows:

Receiving data at a printer; detecting a network address in the received data; requesting authorization to access the network (claims 10, 11, 12, 13 and 14 of Application 09/925,650); sending on the Internet or other network an access request for a document to the network address; retrieving the document from the network address and printing the document.

Furthermore, there is no apparent reason why applicant would be prevented from presenting claims corresponding to those of the instant application in the other copending application. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(e) the invention was described in-

(1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effect under this subsection of a national application published under section 122(b) only if the international application designating the United States was published under Article 21(2)(a) of such treaty in the English language; or

(2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that a patent shall not be deemed filed in the United States for the purposes of this subsection based on the filing of an international application filed under the treaty defined in section 351(a).

3. Claims 1, 2, 3, 4, 5, 6, 7, 8, 9, 10, 17, 18, 22, 23, 24, 25, and 26 are rejected under 35 U.S.C. 102(e) as being anticipated by Tabata et al (Tabata) (U. S. 6,537,324).

With respect to claims 1, 5, 22, 24, 25, and 26, Tabata discloses a printing method comprising receiving data adapted to contain a network address at a printer (470B) (column 23, lines 56-63 and column 24, lines 11-17); determining whether an external network option is enabled (which reads on transferring the address to a file server) (column 24, lines 14-17); detecting if a network address is in the received data (column 23, line 56 to column 24, line 17); sending on the Internet an access request for a document to the network address (column 24, lines 18-23); retrieving the document (column 24, lines 24-25), and printing the document (column 24, lines 36-38).

With respect to claim 2, Tabata discloses the address is a URL (column 12, lines 43-47).

With regard to claims 3 17, 18, and 23, Tabata discloses detecting a barcode (column 6, lines 26-37).

With regard to claim 4, Tabata discloses printing the untranslated barcode (column 26, lines 32-46).

With respect to claims 6 and 7, Tabata discloses presenting a display to the user for enabling the network access option (column 5, lines 51-58).

With regard to claims 8, 9, and further with regard to claim 24, Tabata discloses enabling the URL from a control panel at the printer (the integration of the printer, scanner and terminal equipment) (column 27, lines 9-33).

With respect to claim 10, the control panel is at a remote location (10).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 11, 12, 13, and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tabata in view of Russell et al (Russell) (U. S. 6,375,078).

With respect to claims 11, 12, 13, and 14, Tabata differs from claims 11, 12, 13, and 14 in that he does not clearly disclose sending a user name or password to the remote administration location. Russell discloses a method for retrieving information from a network source wherein authorization for access to the network occurs by requiring the user to enter an access code (column 19, line 55 to column 20, line 6). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Tabata wherein a user name

or password is sent to the remote administration location. It would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Tabata by the teaching of Russell in order to improve the security of the system.

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 15 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tabata in view of Wolff (U. S. 5,848,413).

With respect to claims 15 and 16, Tabata differs from claims 15 and 16 in that he does not clearly disclose receiving E-mail containing the data. Wolff discloses a method for retrieving data from the Internet wherein the data is retrieved via E-mail (column 10, lines 37-48). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Tabata wherein the data is received by E-mail. It would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Tabata by the teaching of Wolff in order to allow for simplified access to the Internet.

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made

to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 19, 20, and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tabata in view of Wolff.

With respect to claims 19, 20, and 21, Tabata differs from claims 19, 20, and 21 in that he does not clearly disclose printing the document within another document and identifying the contents of the documents. Wolff discloses printing the document within another document and identifying the contents of the documents (column 6, lines 29-37 and lines 58-62). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Tabata to print the document within another document and identify the contents of the documents. It would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Tabata by the teaching of Wolff in order to allow greater user control of the formatting of the retrieved documents.

Response to Arguments

1. Applicant's arguments filed 2/20/04 have been fully considered but they are not persuasive.

With respect to the Double Patenting rejection, Applicant submits that the claims in the copending application (09/925,649) differ from those in the instant application. The Examiner disagrees.

The steps of requesting an authorization and detecting that authorization as claimed in application 09/925,649 do not make the claims in that application substantially different from the claims of the instant application. Furthermore, there is no apparent reason why applicant would

be prevented from presenting claims corresponding to those of the instant application in the other copending application. For those reasons, the Examiner maintains his arguments made with respect to the Double Patenting rejection, and **that rejection is therefore made final.**

With regard to the rejections made under 35 USC § 102, Applicant submits that, in the *Tabata* reference, the printer and scanner are different devices. The Examiner respectfully disagrees.

Tabata clearly discloses a copying machine (470) with a scanner unit and printer unit **integrated into one device** (column 23, lines 10-12). The scanner unit of the copier reads information on a medium form (420) and the printer unit of the copier prints out received information (column 23, lines 56-63 and column 24, lines 36-38). It is erroneous for Applicant to conveniently disregard *Tabata*'s disclosure and state that irrespective of integration, the scanner and printer are different devices. Additionally, it is notoriously well known to persons of ordinary skill in the art that a copier comprises a scanner to read a document and a printer to print images.

Applicant also submits that *Tabata* does not disclose determining whether the network option is enabled. The Examiner disagrees. *Tabata* discloses identifying the file server (which reads on determining whether the network option is enabled) (column 7, lines 15-20, column 13, lines 1-14, column 13, line 63 to column 14, line 11, and column 19, lines 55-60).

Applicant also submits that there is no disclosure that the act of transferring data to the file server is a test to determine if it can be transferred or not. Applicant is arguing subject matter not being claimed.

Applicant also submits that *Tabata* does not data containing an address. Applicant agrees that the scanner unit of *Tabata* (figure 20) reads the medium and reads a code area on the medium (see Applicant's arguments on page 6 to page 7). *Tabata* further discloses that the scanner reads an address (URL) from the medium (column 24, lines 11-17). Since the scanner and printer units are integrated into one unit, it is obvious that the copier (or printer 470) reads the address information.

Conclusion

9. THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

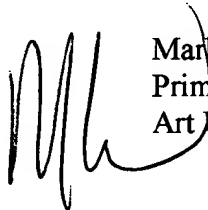
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark E. Wallerson whose telephone number is (703) 305-8581. The examiner can normally be reached on Monday-Friday - 6:30-4:00.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kimberly Williams can be reached on (703) 305-4863. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Mark E. Wallerson
Primary Examiner
Art Unit 2626